

Election
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J-5-02

IN THE US PATENT AND TRADEMARK OFFICE

Application Number: 09/853,870
Agent's Docket Number ONX-117B
Filing Date: May 11, 2001
5 Applicant: Murali Chaparala
Application Title: MAGNETIC POSITION DETECTION APPARATUS
FOR MICRO MACHINED OPTICAL ELEMENT
Examiner: Omar R. Rojas
Art Unit: 2874

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ELECTION RESPONSE

Commissioner of Patents and Trademarks
Washington, DC 20231

Sir:

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In response to the Election/Restriction Requirement Mailed January 24, 2003 (Paper No. 5) kindly consider the following Remarks.

REMARKS

ELECTION/RESTRICTION REQUIREMENT

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The Examiner has required election of claims directed to one of the following species under 35 U.S.C. § 121: Figs. 2A, 5A, 5B, 5C, 5D, and 6. The Examiner has advised the Applicant to list all claims readable on the elected species.

The Applicant hereby provisionally elects, the following species identified in Fig 2A, claims 1-5, 7, 9, 10, 11-18, and 20 with traverse.

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The Applicant traverses the requirement on the grounds that it is improper since the Examiner has not met his burden under MPEP 816 to give reasons for his holding of distinctness. MPEP 816 states that the Examiner should concisely state the reasons that the species are distinct. The Examiner has set forth only a conclusion that the five species

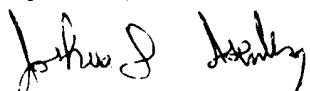
are distinct and has set forth no particular reasons that he has relied on in holding that the species are patentably distinct. MPEP 816 clearly states, “[a] mere statement of conclusion is inadequate.” In the absence of reasons, the inventions cannot be held to be distinct and the requirement should be withdrawn. Therefore the Applicant respectfully requests that the Examiner withdraw the election requirement.

Furthermore, the Applicant notes that the elected species claim 1, which the Examiner has indicated is generic. The Applicant submits that claim 1 is a generic claim linking the elected species to all non-elected species. As such, should claim 1 be allowed, the Applicant submits that, according to see MPEP 809.04 the Examiner must examine all the non-elected claims linked by claim 1, i.e., claims **6, 8, 19 and 21-26**.

CONCLUSION

The applicants respectfully request that the Examiner withdraw the restriction requirement, consider the application and point out the allowable subject matter in the next Office Action.

Respectfully submitted,



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Patent Agent
Reg. No. 41,088

Date: Feb 22, 2003

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